

U.S.S.N. 10/065,639

-7-

3707 (LC 0101 PUS)

REMARKS

Claims 12-17 and 19 and 21 are currently pending in the above application.

Claims 12-17 and 19 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hudkins et al. (U.S. Patent No. 6,296,733) in view of Bell et al. (U.S. Patent No. 6,787,593). Applicants respectfully traverse the Examiner's rejection for reasons previously presented.

In the September 16, 2005 Response to Arguments, the Examiner first states that the declaration is not commensurate with the scope of the claims in that the claims do not require completely formed nibs that do not break off easily during use. Applicants respectfully disagree. However, in order to move this case towards allowance, Applicants have amended independent claims 12 and 21 such that the nibs are "completely formed nibs" and added the phrase "wherein said completely formed nibs do not break easily during subsequent use." Completely formed nibs are shown by reference numeral 26 in Figure 2 of the originally filed application, while support for the phrase "wherein said completely formed nibs do not break easily during subsequent use" is found by reviewing the various mechanical properties for the throw-in mat listed in Table 2 of the originally filed application. As such, Applicants respectfully suggest that the declaration is now commensurate with the scope of the claims as the Examiner suggests.

Second, the Examiner states that the claims do not exclude the presence of filler. The Applicants have never stated that the claims exclude the presence of filler. In fact, the preferred composition of the backing material as presented in Table 1 of the originally filed specification lists calcium carbonate comprising about 55.5 percent by weight of the composition. What Applicants have consistently stated throughout the prosecution of this application is that the Bell reference requires an ethylene-octene copolymer having a melt index between 1 and 10 and a substantial amount of filler in order to achieve sound deadening characteristics (i.e. a much greater than any range of filler taught in the present

U.S.S.N. 10/065,639

-8-

3707 (LC 0101 PUS)

invention). The introduction of this additional amount of filler in Bell would disrupt the flow characteristics of the ethylene-octene copolymer such that they could not form complete nibs as described in the present invention. Moreover, the incompletely formed nibs have a tendency to break off more easily as compared with completely formed nibs. Finally, the highly filled nature of the polymer in Bell affects the mechanical properties of the matting, resulting in nibs would also tend to break off more easily for this reason. Applicants have thus concluded that the polymer described in Bell, in combination with Hudkins, would result in a matting in which the nibs formed are incomplete and would break off easily, while the nibs formed in the present invention are complete and would not break off easily.

The Examiner also states that the declaration is merely an opinion declaration by the Applicants and have cited *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* in establishing the probative value of an expert opinion, and concluded that the Applicant's arguments were unpersuasive. Applicants respectfully disagree, noting first that the opinion testimony *Ashland Oil* is related to invalidating claims of a patent in a patent infringement suit, and is not related to opinion evidence related to a declaration filed in the prosecution of a patent. Even so, opinion evidence by an interested party should have been considered:

While the opinion testimony of a party having a direct interest in the pending litigation is less persuasive than opinion testimony by a disinterested party, it cannot be disregarded for that reason alone and may be relied upon when sufficiently convincing.

Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 U.S.P.Q. 657, 665 (Fed. Cir 1985); quoting *In re McKenna*, 203 F.2d, 717, 720 (CCPA 1953). Such opinion testimony, even through an interested party, should have been considered by the Examiner. Moreover, in the present case, the underlying factual basis presented by the Applicants, who must considered experts in the field, in assessing the Bell reference and its applicability for use as an obviating reference presents a compelling argument that the polymer composition of Bell is inappropriate for forming a throw-in mat having completely formed nibs that do not break off easily as in the present claims. Further, the Examiner

U.S.S.N. 10/065,639

-9-

3707 (LC 0101 PUS)

provides no expert testimony from a disinterested party that refutes Applicants' declaration. In assessing all of the *Ashland Oil* factors listed by the Examiner on page 3 of the Office Action, most, if not all of the factors support Applicants' arguments and refute the Examiner's arguments. As such, Applicants respectfully submit that the Examiner should have considered the Applicants' declaration and concluded that the polymer described in Bell could not be used in the present invention. As such, the combination of references cited by the Examiner does not obviate claims 12-17 and 19. Reconsideration of claims 12-17 and 19 is thus respectfully requested.

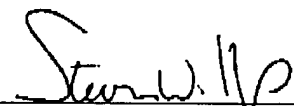
As such, Applicants respectfully submit that amended independent claim 12, and dependent claims 13-17, 19 therefrom, are in proper form and allowable. Also, amended claim 21 is also in proper form and allowable.

Applicants respectfully suggest that claims 12-17, 19, and 21 are allowable. The Examiner is invited to telephone the Applicants' undersigned attorney at (248) 223-9500 if any unresolved matters remain.

Respectfully submitted,

ARTZ & ARTZ, P.C.

By: _____


Steven W. Hays
Reg. No. 41,823
28333 Telegraph Road
Suite 250
Southfield, MI 48034
(248) 223-9500

Dated: October 27, 2005